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REMARKS/ARGUMENTS

In the Office Action dated June 29, 2005, Claims 1-34 were noted as pending in the application. Applicants appreciate the Examiner noting that Claims 1-3 and 7-29 are allowable in their present form. In the Office Action it is noted that Claims 4-5, 30-31, and 33 were rejected under 35 U.S.C. 102(a) and Claims 6, 32, and 34 were rejected under 35 U.S.C. 103(a).

By the present amendment, Claims 4 and 30-34 have been amended and Claims 5-6 have been cancelled without prejudice. Applicants respectfully submit that all of the claims are now in a form for allowance. The Applicants will generally respond to the Official Action in the general order in which it was presented.

A. Claim Rejections – 35 U.S.C. § 102 – Claims 4-6, 30-31, and 33

In the Office Action, Claims 4-5, 30-31, and 33 are rejected under 35 U.S.C. 102(a) as being anticipated by *Monico* (U.S. Patent No. 6,021,942). In response to this rejection, Applicants respectfully request to cancel, without prejudice, claim 5, amend claims 4, 30-31, and 33, and to have allowed the pending claims (amended).

Applicants respectfully submit that the rejection of all the claims of the present application based on being anticipated by the *Monico* reference is not proper in that every element of each claim of the application is not disclosed in the *Monico* reference. However, Applicants have amended the above-identified claims to further distinguish the present invention from *Monico* and to improve readability for the Examiner.

1. The Rejection

The Office Action provides in part for all claims rejected under 102(a) that:

Monico teaches a method of altering the delivery of an item when an attempted delivery of the item by a delivery service has been unsuccessful and the intended recipient has been provided a delivery notice code, comprising contacting the delivery service, using the delivery notice code to access information about the item wherein the information includes delivery plans for the parcel and modifying the delivery plans based upon subsequent instructions from the recipient.

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2. The *Monico* Reference

The invention disclosed in *Monico* is directed toward a three-part delivery notice having a first section, a second section and a third section. The third section is a first delivery attempt notice, the second section is a second delivery attempt notice, and the first section indicates a reason for delivery failure (reference FIG. 1 of the patent). Each portion of the three-part delivery notice in *Monico* has machine-readable and human-readable indicia. Unlike the present invention, common indicia are used on each section of the delivery notice in *Monico*. *Monico* reads as follows at column 5, lines 1-42:

"The first section 21 typically includes identification indicia shown generally by reference 33 in FIG. 1, and including a machine-readable (e.g. bar code) part 34, and a human-readable part 35. The first section 21 also comprises a plurality of (at least two, and preferably at least three) reason for non-delivery indicia. These indicia all include a machine-readable (e.g. bar code) part 36 and a corresponding human-readable part 37. The particular reason for non-delivery indicia illustrated in FIG. 1 include "wrong address", "consignee moved", "consignee not at home", "office closed", "damaged", "refused delivery", "not delivered (no time)", "wrong route", and "other". The "other" indicia is followed by lines 38 facilitating the entry of handwritten information. The above reasons for non-delivery are exemplary only and different or other wording and/or reasons may be provided. The third section 23, which may be connected directly to the first section 21 if the second section 22 is not provided, preferably includes indicia 133 in common with the indicia 33 (except having an extender indicating the first attempt at delivery). This includes a machine-readable part 134 and a human-readable part 135, with the extenders 40, 41. The indicia imaged on the third section 23 also preferably includes human-readable indicia 42 (e.g. "first attempt") indicating a first attempt to deliver a package, and preferably also includes a toll-free telephone number indicia 43 to call if an indicated redelivery time is inconvenient, to request redelivery, and/or for questions, and one or more blank areas 44 for the entry of handwritten indicia indicating potential other delivery dates or times. Also there may be indicia 45 indicating that if the addressee/consignee would like the package merely left at the door that he or she can sign at the indicia 46 and on the next delivery the package will merely be left at the door. Other suitable indicia also may be provided, as illustrated in the example in FIG. 1.

The second section 22 also includes identification indicia 233, but with a different extender 240, 241, the indicia 233 – except for the extender – in common with the indicia 33, 133." (Emphasis in boldface type added.)

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Stated simply, *Monico* discloses a business form and method of use in which a notice associated with each undelivered package is left behind each time an attempted delivery is made. The notice is not related to the delivery event, rather to an individual code on each form used to identify each package separately. This results in that there can be *more than one* delivery notice bearing the *same* indicia left at an addressee's location for the *same* package if multiple delivery attempts are made. Furthermore, this also results in *more than one* notice left behind *each time* a delivery attempt is made if multiple packages are undeliverable.

Claim 4:

Claim 4 is a method claim for the intended recipient of an undeliverable package to access and modify a delivery service's redelivery plans for such undelivered items by using a delivery notice code. A package that was undeliverable during a delivery stop is linked to a delivery notice code and the delivery notice code is used by the intended recipient to access to the redelivery plans for such an undeliverable package. Amended Claim 4, as shown below, is further distinguished from *Monico* in that the delivery notice code is separate and distinct from any indicia on the undelivered item.

Monico clearly does not disclose using a delivery code notice, separate and distinct from the package indicia, to allow the intended recipient to access information regarding the package without the package indicia. For these reasons, Applicants respectfully submit that Claim 4 is patentably distinct over the *Monico* reference. Claim 4, as amended reads:

4. (Currently Amended) A method of altering the redelivery plans of an item having an item code that is associated with a delivery notice code on a delivery notice that is provided to an intended recipient when an attempted delivery of said item by a delivery service has been unsuccessful ~~and the intended recipient has been provided a delivery notice code~~, comprising:

- a. contacting the delivery service;
- b. using said the delivery notice code that is associated with said item code to access information about said item wherein said information includes

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- redelivery plans for the parcel said item and said delivery notice code is not the same as said item code; and
- c. modifying the redelivery plans for said item based upon subsequent instructions from said intended recipient.

Claims 5:

Claim 5 has been cancelled, without prejudice, as of this amendment. The applicants respectfully request that rejection of this claim be withdrawn.

Claim 30:

Claim 30, as amended, is now a dependent claim that in combination with (amended) independent Claim 4, above, is not disclosed by *Monico* and, therefore, is submitted to be proper for allowance on its merits. Reconsideration of this claim's patentability is respectfully requested.

Claims 31 and 33:

Claims 31 and 33, as amended, are dependent claims that in combination with (amended) independent Claim 4, above, are not disclosed by *Monico* and, therefore, are submitted to be proper for allowance on its merits. Reconsideration of the patentability of these claims is respectfully requested.

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B. Claim Rejections – 35 U.S.C. § 103 – Claims 6, 32 and 34

1. **The Rejection**

In the Office Action, Claims 6, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Monico* in view of *Knowles et al.* (U.S. Patent No. 5,869,819, hereinafter "*Knowles*"). The Office Action provides in part that:

"In view of the teaching of *Knowles*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an internet connection for transmitting data because it is well known in the art that the internet is a reliable, convenient, and safe way to transmit data."

2. **The *Knowles* Reference**

Knowles discloses in its Abstract:

"A novel Web-based package routing, tracking and delivering system and method that uses URL/ZIP-CODE encoded bar code symbols on parcels and packages. The system comprises one or more Routing, Tracking and Delivery (RTD) Internet Server Subsystems connected to the Internet infrastructure and updated at any instant of time with package tracking information. A Package Log-In/Shipping Subsystem is located at each shipping location and connected to the RTD Internet Server by way of the Internet infrastructure. A Package Routing Subsystem is located at a hub station and connected to the RTD Internet Server by way of the Internet infrastructure. A Portable Package Delivery Subsystem is carried by each package delivery person, and connected to the RTD Internet Server by way of the Internet infrastructure communication link. At each remote hub station within the system, the URL/ZIP-CODE encoded bar code symbol is automatically scanned by way of the Internet infrastructure; the encoded destination Zip Code is locally recovered and used to route the package at the hub station; and the locally recovered URL is used to access the RTD Internet Server and update the location of the package within the system. The Portable Package Delivery Subsystem is used to read the URL/ZIP-CODE encoded bar code symbol near the delivery destination in order to access the RTD Internet Server and display delivery information and the like to facilitate the delivery process."

Applicants respectfully submit that generally, *Knowles* discloses systems and methods for package-tracking that utilize a specialized bar-code that includes an Internet uniform resource locator ("URL"). Each parcel or package has an Internet website established such that the

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package may be tracked by scanning the URL-encoded barcode at various locations throughout the delivery process and updating the package's website. Other information, such as delivery instructions may also be included on the website and may be accessed by a delivery person using a portable scanner with Internet access.

3. Applicants' Response

Applicants respectfully submit that for an obviousness rejection to stand, it must meet two requirements: (1) existence of a prior art reference and (2) a suggestion by the prior art that the modification proposed in the application is desirable. *See In re Laskowski*, 781 F.2d 115 (Fed. Cir. 1989). It is stated in the Office Action that *Monico* fails to disclose that an Internet connection is used for receiving data. Furthermore, the Office Action concedes that "*Knowles* teaches an internet-based system and method for tracking objects bearing URL-encoded bar code symbols."

As noted above, Applicants submit that *Monico* does not teach or suggest the present invention. Furthermore, *Knowles* does not teach the transmission of information linking the indicia of a delivery notice to indicia on a package as is disclosed in the Applicants' invention. In order for a obviousness rejection under *Monico* in light of *Knowles* to exist, *Monico* must suggest that the modification suggested by *Knowles*, tracking via the internet, is desirable. This would require *Monico* to disclose any method of contacting a delivery service which is convenient, safe, and reliable can be used in its invention. *Monico*, however, only discloses the use of a toll-free number to contact the delivery service and no other suggestion or support for other methods to contact the carrier. Applicants respectfully submits that the fact that the Office Action states that the use of an internet connection, the element added under *Knowles*, to contact a delivery service is possible under *Monico* is insufficient to result in an obviousness rejection, since the use of hindsight in an Office Action is improper in formulating a section 103 rejection. As stated in *Interconnect Planning Corp v. Feil*: "When prior art references require selective combination . . . to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself." 774 F.2d 1132, 1143 (Fed. Cir. 1985). In hindsight, *Monico* could have used the internet connection of *Knowles* to allow an intended recipient to contact the delivery service, but no such reference or desire is

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present in *Monico*. Therefore, Applicants respectfully submit that unless motivation can be found in *Monico* suggesting the use of any reliable, convenient, and safe way to transmit data is desirable, an obviousness rejection in light of *Knowles* should not stand.

Applicants further respectfully submit that Claims 32 and 34 of the Application are now dependent claims that depend from claims that are allowable based on the arguments in the previous section concerning Claim 4 and *Monico*. These dependent claims add the element of utilizing the Internet as a medium to contacting the delivery service and providing instructions from an intended recipient. They do not teach or suggest providing access to a specific URL regarding a particular parcel, as is taught in *Knowles*.

Therefore, Applicants respectfully submit that dependent Claims 32 and 34 are patentable on their own merit over *Monico* in view of *Knowles* and are in a form for allowance. Claim 6 has been cancelled and the applicants respectfully request withdraw of the rejection.

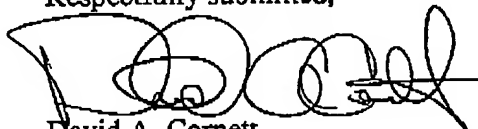
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C. Conclusion

As of this amendment, Claims 1-4 and 7-34 remain pending in the Application. Applicants respectfully submit that all pending claims are patentably distinguishable over the prior art of record, and therefore, all claims are in form for allowance.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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Shana Moore

7/25/05
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